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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/753,338

01/09/2004

Morimichi Watanabe

246924US3 DIV

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08/07/2006

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EXAMINER

GILBERT, WILLIAM V

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/753,338	<b>Applicant(s)</b> WATANABE, MORIMICHI	
	<b>Examiner</b> William V. Gilbert	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,6,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

1. This is an Action on the Merits resulting from a response to an Election/Restriction dated 26 April 2006. Claims 1, 6, 14 and 15 are pending. Claims 1 and 6 are withdrawn from consideration for reasons set forth below. Claims 14 and 15 are examined as follows.

***Election/Restrictions***

2. Applicant's election with traverse of Species I, Claims 1, 6, 14 and 15 in the reply filed on 26 May 2006 is acknowledged. The traversal is on the ground(s) that the search would not be a serious burden on the Examiner. This is not found persuasive because the claims as claimed would require a continual search of prior art to meet the two separate species that were subject to the restriction.

The requirement is still deemed proper and is therefore made FINAL.

Further, Applicant elected Claims 1, 6, 14 and 15 in correspondence with Species I. It should be noted in the Office Action dated 06 April 2006 that Species I covers Figures 1-10. In reviewing Claims 1 and 6 however, the Examiner concluded that these two claims correspond with Species II as noted in the same

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action. In particular Applicant claims in Claim 1 and Claim 6 as follows:

[T]he engaging groove (152) being formed in a straight line parallel to the upper side portion (12) and the rear surface stepped portion (15).

See Claim 1, lines 17-19 and Claim 6, lines 18, 19 (reference numbers added by the Examiner in accordance with the Applicant's disclosure.) Examiner interprets this to correspond with Species II in that the engaging groove of elected Species I is non-parallel to the upper side portion and rear surface stepped portion, where a portion of the groove in Species II is parallel with the upper side portion and rear surface stepped portion. See Figures 3 and 11 respectively. Claims 1 and 6 are therefore withdrawn from consideration, and the Examiner examined Claims 14 and 15.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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**Claims 14 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (U.S. Patent No. 6,460,311) in view of Eaton (U.S. Patent No. 4,468,909).

Regarding Claim 14, Ito discloses a ceramic siding board (40, Column 6, lines 42-45) having a bottom face, a top face opposite the bottom face, an upper face between the top and bottom faces, the upper face comprising a notched portion (see Figure 8, area proximate 45a), the upper face being formed in a straight line (Figure 8 area proximate 26), a lower face opposite said upper face (Figure 8 area proximate 26), the lower face comprising a stepped portion (Figure 8 area proximate 26 and 26b), the stepped portion being formed in a straight line in parallel to the upper face (Figure 8 area proximate 26), a left face (Figure 11 area proximate S2), comprising a lateral overlying tongue (Figure 11 area proximate S2), and a right face (Figure 11 area proximate S2) having a laterally underlying tongue portion (Figure 11 area proximate S2). Ito does not disclose the top face having vertical joint grooves dividing the top face into plural areas having different widths and heights. Eaton discloses a siding member (Figure 3, element 30) having vertical joint grooves (66) dividing the top face into plural areas having different widths and heights (Figure 3 generally,

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Figure 4, the surface contour elements 50, 54, 54a show varying heights made by vertical grooves). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to place vertical grooves as in Eaton on the panel in Ito. One would have been motivated to make such a modification because the grooves would be more appealing aesthetically and could provide the appearance of numerous individual panels and provide depth to the panels. The phrases "configured to be disposed..." (Page 5, line 14), "configured to be disposed" (Page 5, line 17), "configured to be overlapped..." (Page 5, line 19), "configured to be disposed..." (Page 5, line 21), "configured to overlap..." (Page 6, line 1), "configured to be disposed..." (Page 6, line 3), "configured to form..." (Page 6, line 4), "configured to form..." (Page 6, line 6), "configured to be disposed..." (Page 6, line 8), "configured to form..." (Page 9, line 9), and "configured to form..." (Page 6, line 11) are statements of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding Claim 15, the phrase, "configured to contact a first fastener to fasten the siding board to a structure and the

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stepped portion of the lower face of the siding board is configured to contact a second fastener to fasten the siding board to the structure," is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

#### ***Conclusion***


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571.272.6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WVG  
08/03/06

  
N. Slack  
Supervisory Patent Examiner